

I hereby certify that on January 29, 2010, this correspondence is being submitted to the Patent and Trademark Office via the Office Electronic Filing System in accordance with 37 C.F.R. §1.6(a)(4), addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Marilyn R. Khorsandi Jan. 29, 2010
Marilyn R. Khorsandi

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appeal No. : 2008-005469
Applicant : Bilibin, Paul et al.
Application No. : 09/684,861
Filed : October 6, 2000
Title : Apparatus, Systems and Methods for Determining Delivery
Time Schedules for Each of Multiple Carriers
Technology Center : 3600
Grp./Div. : 3623
Examiner : Boswell [previously Van Doren], Beth
Docket No. : PSTM0024/MRK

MAIL STOP APPEAL BRIEF-PATENTS (Filed Electronically)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
January 29, 2010

**APPELLANTS' REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52 AND
STATEMENT/ARGUMENT**

In accordance with 37 C.F.R. §41.52, Appellants hereby respectfully request Rehearing of the Decision by the Board (the "Appeal Decision") issued on November 30, 2009 in the case of the above-identified application regarding the affirmance of the rejection of Claims 1-13, 15-17 and 19-23.

It is respectfully submitted that this Request for Rehearing is timely filed because it is being filed in accordance with 37 C.F.R. §41.52(a)(1), prior to the expiration of February 1, 2010, which is the first business day following the last day of the two month period (which falls on January 30, 2010, a Saturday) following the November 30, 2009 date of the Appeal Decision.

TABLE OF CONTENTS

STATEMENT/ARGUMENT	4
BACKGROUND SUMMARY	4
POINTS ON APPEAL FOR WHICH REHEARING IS RESPECTFULLY REQUESTED	4
1. <u>Request for Rehearing Point 1 Regarding the Appeal Decision Regarding Appeal Brief Argument 1.</u>	4
1.A. <u>Request for Rehearing Point 1.A Regarding the Appeal Decision Regarding Appeal Brief Argument 1: The FedEx Reference Fails to Disclose, Either Explicitly or Inherently, Ever Determining a Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel, and Moreover, Fails to Disclose Determining the Claimed Limitations for a Cross-Comparison Delivery Schedule that Includes Delivery Dates and Times for Each FedEx® Service.</u>	5
1.B. <u>Request for Rehearing Point 1.B Regarding the Appeal Decision Regarding Appeal Brief Argument 1: The Thiel Table Reproduced in Finding of Fact Number 7 is Not Determined or Generated by the Thiel System In Response to a User Request as Required by Claim 1, and Does Not, Therefore, Disclose the Claimed Limitations for Determining a Cross-Comparison Schedule.</u>	7
1.C. <u>Conclusion Regarding Request for Rehearing Point 1 Regarding the Appeal Decision Regarding Appeal Brief Argument 1.</u>	9
2. <u>Request for Rehearing Point 2 Regarding the Appeal Decision Regarding Appeal Brief Argument 1a.</u>	9
2.A. <u>Request for Rehearing Point 2.A Regarding the Appeal Decision Regarding Appeal Brief Argument 1a: The Thiel Reference Fails to Disclose, Either Explicitly or Inherently, a Cross-Comparison Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel.</u>	9
2.B. <u>Request for Rehearing Point 2.B Regarding the Appeal Decision Regarding Appeal Brief Argument 1a: As Compared to the Limitations of the Claims Which Provide For Determination of a Cross-Comparison Delivery Schedule That Comprises a Delivery Data and Time for Each Delivery Service Offered by Each Carrier in Response to a User Shipping Request,</u>	

<u>the Thiel Reference Discloses a User Having Already Pre-Selected a Delivery Service Before Rates are Calculated.</u>	14
2.C. <u>Request for Rehearing Point 2.C Regarding the Appeal Decision Regarding Appeal Brief Argument 1a: The FedEx Reference Fails to Disclose, Either Explicitly or Inherently, Ever Determining a Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel.</u>	15
2.D. <u>Conclusion Regarding Request for Rehearing Point 2 Regarding the Appeal Decision Regarding Appeal Brief Argument 1a.</u>	17
3. <u>Request for Rehearing Point 3 Regarding the Appeal Decision Regarding Appeal Brief Argument 1b: The Thiel Reference Fails to Disclose, Either Explicitly or Inherently, a Cross-Comparison Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel, and Further Fails to Disclose Determining Elements For Each Delivery Service Offered by Each Carrier That Would Deliver a Parcel.</u>	18
4. <u>Request for Rehearing Point 4 Regarding the Appeal Decision Regarding Appeal Brief Argument 1c: As Compared to the Appeal Decision Statements That the Appeal Brief Argument 1c Relied on the Arguments Under Appeal Brief Argument 1b, Appeal Brief Argument 1c Advanced Additional Reasons Why Claims 3, 6, 9 and 16 Are Patentable .</u>	19
5. <u>Request for Rehearing Point 5 Regarding the Appeal Decision Regarding Appeal Brief Arguments 1d and 1e.</u>	20
<u>REQUEST FOR REHEARING CONCLUSION.</u>	21

STATEMENT/ARGUMENT

BACKGROUND SUMMARY

The Examiner rejected Claims 1-13, 15-17, and 19-21 under 35 U.S.C. §103(a) as being unpatentable over Thiel (U.S. Patent No. 5,699,258; "Thiel") in view of FedEx (www.fedex.com; "FedEx"). Office Action dated December 20, 2005 regarding U.S. Application Serial No. 09/684,861 ("Office Action"), Topic No. 3, p. 2.

The Appeal Decision affirmed the rejection under Section 103(a) of Claims 1-13, 15-17, and 19-23. Appeal Decision, p. 2, ¶1; Appeal Decision, p. 18, ¶2.

Pursuant to 37 C.F.R. §41.52, the Board is respectfully requested to reconsider the following points regarding the Appeal Decision for the above-identified Appeal.

POINTS ON APPEAL FOR WHICH REHEARING IS RESPECTFULLY REQUESTED

1. Request for Rehearing Point 1 Regarding the Appeal Decision Regarding Appeal Brief Argument 1.

The Board decided the Appeal with respect to Argument 1 in view of Claim 1. See Appeal Decision, p. 11, ¶1. Therefore, the following assertions are presented with respect to the limitations of Claim 1.

Claim 1 claims determining a delivery date and a delivery time for each delivery service offered by each carrier that would deliver a parcel. The Examiner asserted, and the Board has affirmed, obviousness of the claimed limitations in view of Thiel (which the Board ultimately confirms does not disclose determining a delivery date or a delivery time (see Appeal Decision, p. 11, ¶2)), and FedEx, both of which, for the reasons described further below, only act regarding a particular delivery service pre-selected by a shipping user, not for each delivery service, offered by each carrier, that would deliver a particular parcel, as claimed, for example, by Claim 1.

**1.A. Request for Rehearing Point 1.A Regarding the Appeal Decision .
Regarding Appeal Brief Argument 1: The FedEx Reference Fails to Disclose,
Either Explicitly or Inherently, Ever Determining a Schedule That
Comprises a Delivery Date and a Delivery Time in Response to a Particular
User Requesting Shipment of a Particular Parcel, and Moreover, Fails to
Disclose Determining the Claimed Limitations for a Cross-Comparison
Delivery Schedule that Includes Delivery Dates and Times for Each FedEx®
Service.**

The Board decided the Appeal with respect to Argument 1 in view of Claim 1. See Appeal Decision, p. 11, ¶1. For the reasons given further below, it is respectfully asserted that the Board appears to have misapprehended the Appeal argument with respect to the claim language of Claim 1, regarding the absence of a disclosure by the FedEx reference regarding a determination of a potential cross-comparison delivery schedule for delivery of a particular parcel, and moreover, regarding the absence of a disclosure by the FedEx reference of a determination of the claimed limitations for a cross-comparison delivery schedule that includes delivery dates and times for each FedEx® service.

The Board found that “FedEx discloses a rules-based delivery schedule” Appeal Decision, Finding of Fact (“FF”) 11. As a basis for that finding, the Board presents descriptions of various FedEx® delivery services quoted from the FedEx reference. See Appeal Decision, Finding of Fact (“FF”) 11 (e.g., describing, “FedEx First Overnight®” as providing “[d]elivery of critical shipments by 8 a.m. the next business day to 90 major U.S. markets....”).

The Board interpreted Appellants' argument that “...there is no disclosure of a determination of a schedule or a calculation of shipping costs for delivery of a particular parcel in the FedEx reference ...” as possibly meaning that Appellants were arguing that “... the FedEx reference fails to explicitly state that these rules are actually used” Appeal Decision, p. 11, ¶3. The Board concluded that FedEx® must execute its rules because it eventually bills a customer for shipping an item. See Appeal Decision, p. 11, ¶3 (“... we find that the very nature of FedEx as a shipping carrier makes such usage necessary and inevitable to simply carry out its business operations. It would be impossible to bill a customer and earn revenues without executing the rules that spell out how fares are computed.”).

Although it is respectfully acknowledged that the Board correctly concludes that FedEx® must at some point calculate a fee for billing a customer, Appellants were actually arguing that the FedEx reference amounts to nothing more than a general description of various services offered by FedEx® that explains general time frames and general delivery-timing rules that FedEx® applies to shipments, as compared to the claimed limitations of determining a potential cross-comparison delivery schedule comprising dates and times in response to a respective request by a respective particular user to ship a particular respective parcel.

Further, although it is respectfully acknowledged that the Board correctly concludes that it is inherent in the way that FedEx® does business that FedEx® must at some point calculate a fee for billing a customer, it is respectfully asserted that it is not inherent in the way that FedEx® does business that FedEx®, at the time of the claimed invention, would have necessarily determined a particular delivery date and time for delivering a particular parcel. It is respectfully acknowledged that, as pointed out by the Board, FedEx® would apply its rules to deliver a particular parcel. However, it is respectfully suggested that FedEx® could have done so, at the time of the claimed invention, in a number of ways that would not have involved FedEx® ever determining a delivery date and a delivery time for delivery of the particular parcel to a particular destination.¹

Yet further, it is respectfully asserted that it is inherent in FedEx® calculating a fee for billing a customer, that FedEx® would calculate such a fee for the FedEx® delivery service that the shipping user had actually selected for shipping a parcel.

¹In order to deliver a parcel, it is respectfully asserted that, at the time of the present invention, FedEx® could have applied, for example, a From-Address-Zip-Code/Destination-Address-Zip-Code sorting rule to sort a particular parcel to a particular transit route; FedEx® would then endeavor to deliver the particular parcel to its addressed destination through that transit route in accordance with FedEx®'s rules for the particular delivery service that had been selected by the user. However, it is respectfully asserted that FedEx® could have applied its rules for a particular delivery service in a number of ways that would not have involved FedEx® ever determining a delivery date and a delivery time for delivery of the particular parcel to a particular destination. For example, it is respectfully suggested that FedEx®'s rules for delivery through a selected transit route could have been implemented using a priority indicator, such as, for example, a combination of a Ship Date, with an indication of the user-selected delivery service.

As compared to an inherent calculation by FedEx® of a fee for delivery of a particular parcel according to a particular FedEx® delivery service that had been selected by a user, and even assuming for the sake of argument only that FedEx® would, at the time of the claimed invention, determine a delivery date and delivery time for delivering a particular parcel, it is respectfully asserted that Claim 1 claims limitations not disclosed by the FedEx reference or the way in which FedEx® did business at the time of the claimed invention, for determining a delivery schedule that "... comprises a respective delivery date and a respective delivery time *for each respective particular delivery service* ... offered by each respective particular carrier ... that would deliver the particular respective parcel" Claim 1 (emphasis added).

1.B. Request for Rehearing Point 1.B Regarding the Appeal Decision Regarding Appeal Brief Argument 1: The Thiel Table Reproduced in Finding of Fact Number 7 is Not Determined or Generated by the Thiel System In Response to a User Request as Required by Claim 1, and Does Not, Therefore, Disclose the Claimed Limitations for Determining a Cross-Comparison Schedule.

It is respectfully asserted that the affirmance by the Board of the Claim rejections appears to be based on a misapprehension that Thiel discloses generating (or as claimed by Claim 1, determining) a cross-comparison table regarding various delivery services offered by various carriers in response to a user shipping request. See Appeal Decision, p. 6, Finding of Fact ("FF") 7 (displaying the Thiel Table); see also, Appeal Decision; p. 9, FF 13 (referring to the Thiel Table in FF 7 as a "resulting comparison"); Appeal Decision, p. 14, ¶1 ("... generating the comparison table in Thiel is also done in response to a user request"). Further, it is respectfully asserted that the affirmance by the Board of the Claim rejections appears to have misapprehended Appellants' argument regarding the way in which the Thiel Table is used by the Thiel system. In particular, the Board disagreed with Appellants' statement that "... the stored Thiel table is used to perform a mask search *after* the user has already 'defined the required services'." (Appeal Br. 20)." Appeal Decision, p. 14, ¶2. The Board concluded that "... there is nothing in claim 1 which requires the recited steps to be carried out in any given order as so argued." Id.

It is respectfully asserted, for the reasons given further below, that Appellants

were asserting the requirement by Claim 1 that the claimed cross-comparison delivery schedule comprise delivery dates and times for *each* delivery service offered by each carrier, not, as done in Thiel for fees, only for a *pre-selected* delivery service. Further, Appellants were asserting the requirement by Claim 1 that the claimed cross-comparison is determined in response to a user shipping request.

First, Thiel explicitly discloses that the Thiel Table reproduced in FF 7 of the Appeal Decision (the "Thiel Table") is "download[ed] and stor[ed] ... into ... [a] predetermined memory region[] ..." (Thiel, col. 2, lines 56-62). Further, after being downloaded and stored, the Thiel Table is then accessed by the Thiel system to "... search[] the carriers which offer the *desired services* ..." (Thiel, col. 11, lines 22-23; emphasis added for reasons given further below). Thus, the table disclosed in Thiel is not determined or generated by the Thiel system *in response to a user request* as required by Claim 1.

Moreover, as compared to a table of elements that are determined or generated by the Thiel system for *each delivery service* offered by *each carrier* that would deliver a particular parcel as claimed, for example, by Claim 1, it is respectfully asserted that Thiel discloses that the Thiel system relies on a user *first pre-selecting* a delivery service, so that the Thiel system can then calculate rates for the pre-selected delivery service for various carriers that offer that delivery service. In particular, Thiel discloses that before the cited Thiel Table is used:

The user of the franking machine first defines the required services. This is done by entering the date with regard to the ship-to zone (the destination zone) and the desired additional services such as express delivery (E), return receipt (R), etc. ... In a first selection process, a mask (a first step selection) searches the carriers which offer the desired services.

Thiel, col. 11, lines 15-23.

That is, Thiel discloses a user first pre-selecting a delivery service, such as, for example, "express delivery," and then discloses that the Thiel Table is used by the Thiel system to identify carriers that would provide the user-pre-selected delivery service (and user-requested shipping features); once the carriers have been determined, Thiel then discloses using the Thiel Table to calculate shipping rates *only for the user-pre-selected*

delivery service. It is respectfully asserted that, in view of the above-mentioned disclosures by Thiel, the cited Thiel Table does not contain calculated shipping rates for shipping a particular parcel. Moreover, it is respectfully asserted, in view of the above-mentioned disclosures by Thiel, that Thiel does not disclose generating or otherwise determining a table of elements (such as shipping rates) that are determined for each delivery service offered by each of various carriers as claimed, for example, by Claim 1.

1.C. Conclusion Regarding Request for Rehearing Point 1 Regarding the Appeal Decision Regarding Appeal Brief Argument 1.

For the above-given reasons, and for the reasons previously given in Appellants' Appeal Brief and Reply Brief, it is therefore respectfully asserted that Claim 1 is non-obvious in view of, and is therefore patentable over, the FedEx and Thiel references. Further for reasons similar to those given above regarding Claim 1, it is therefore respectfully asserted that the other Claims argued under Appeal Brief Argument 1, namely Claims 2-13, 15-17, and 19-23, are non-obvious in view of, and are therefore patentable over, the FedEx and Thiel references.

2. Request for Rehearing Point 2 Regarding the Appeal Decision Regarding Appeal Brief Argument 1a.

The Board decided the Appeal with respect to Appeal Brief Argument 1a in view of Claim 1. See Appeal Decision, p. 11, ¶1. Therefore, the following assertions are presented with respect to the limitations of Claim 1.

2.A. Request for Rehearing Point 2.A Regarding the Appeal Decision Regarding Appeal Brief Argument 1a: The Thiel Reference Fails to Disclose, Either Explicitly or Inherently, a Cross-Comparison Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel.

Even though the Board seems to agree that Thiel does not disclose a cross-comparison delivery schedule (see Appeal Decision, p. 11, ¶2 ("... the Examiner acknowledges that Thiel does not disclose the schedule feature (FF 4) ...")), the Appeal Decision also sets forth a seemingly inconsistent position. See, e.g., Appeal Decision,

p. 13, ¶¶2-3 (“The Examiner however found that Thiel discloses a cross comparison delivery schedule in the Table listed supra (FF 7) ... We agree with the Examiner.”); see also, e.g., Appeal Decision, p. 9, FF 12 (“The Examiner found that Thiel discloses a cross comparison *delivery schedule* in the Table listed supra (FF 7) ...” (emphasis added)).

The Board adopted “the ordinary and customary definition of ‘schedule’ ... ‘[a] time-based plan of events.’ (FF 2)” Appeal Decision, p. 13, ¶3. The Board concludes that, “[u]sing the ordinary and customary definition of the term ‘schedule’, we find that the comparison table (FF 7) in Thiel is a schedule because Thiel discloses that at least one of the data entered as part of the required shipping information data is the proposed date of mailing of the item (FF 13). Thus, we find that because the comparison uses a date to generate a comparison schedule, it is time-based and thus meets the definition of a schedule.” Appeal Decision, p. 13, ¶3 – p. 14 (top of page).

It is respectfully asserted that the above-mentioned seemingly inconsistent positions appear to be based on a misapprehension of the claimed term “cross-comparison delivery schedule.” The Appeal Decision indicates that it adopts the interpretation of the term “delivery schedule” as “... the ordinary and customary definition of ‘schedule’ which we find to be: ‘[a] time-based plan of events.’ (FF 2).” Appeal Decision, p. 13, ¶3.

However, as compared to the above-described “ordinary and customary definition” of the claimed term “delivery schedule,” it is respectfully submitted that Claim 1, for example, explicitly recites that the claimed “... delivery schedule comprises a respective delivery date and a respective delivery time for each respective particular delivery service ... offered by each respective particular carrier ... that would deliver the particular respective parcel” Claim 1. Based on the aforementioned express recitations of, for example, Claim 1, it is respectfully asserted that Thiel fails to disclose every claimed limitation of the claimed cross-comparison delivery schedule.

Further, for the reasons previously given above, which are incorporated here for all purposes, it is respectfully asserted that the Board’s conclusion that the Thiel Table is a delivery schedule appears to misapprehend the content of the Thiel Table as content that has been generated by the Thiel system. See, e.g., Appeal Decision, p. 14,

¶1 (disagreeing that the Thiel Table is a stored table that has not been determined by the Thiel system, "because Thiel discloses that this data is stored 'as a supplementary function in such a way that it can be called up and ascertained in a further memory region A, B, C, etc., for each country, and the appropriate zone....' (FF 14).").

For the reasons previously given above, which are incorporated here for all purposes, as compared to a comparison table that is generated in response to a user request as claimed, for example, by Claim 1, it is respectfully asserted that the Thiel Table is not generated by the Thiel system. See, e.g., Thiel, col. 2, lines 56-62 (disclosing that the Thiel Table is "download[ed] and stor[ed] ... into ... [a] predetermined memory region[] ..."); Thiel, col. 11, lines 22-23 (disclosing that the Thiel Table, after being downloaded and stored, is then accessed by the Thiel system to "... search[] the carriers which offer the desired services ...").

It is respectfully asserted that the Thiel Table does not disclose containing any fees that have been calculated by the Thiel system for delivering a parcel. Rather, it is respectfully asserted that the Thiel Table contains various settings that are used by the Thiel system for calculating shipping fees, but are not, themselves, calculated shipping fees. Further, it is respectfully asserted that no dates or times are listed in the Thiel Table. See also, e.g., Appeal Brief, Argument Regarding Issue 1a, p. 18, ¶3 ("... the cited stored Thiel table merely lists, for five (5) different carriers, such shipping features as Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. Thiel, col. 11, lines 1-13. No dates or times are listed.")

Yet further, as previously explained in the Appeal Brief (see, e.g., Appeal Brief, Argument Regarding Issue 1a, p. 20, ¶2), it is respectfully asserted that Thiel uses the settings in the cited stored Thiel Table to calculate shipping costs for the carriers that would offer a delivery service that has been pre-selected by the user. See, e.g., Thiel, col. 11, lines 15-30.

It is respectfully asserted that the portion of Thiel's disclosure cited by the Appeal Decision regarding the storing of the Thiel [postal rate] Table (see Appeal Decision, p. 9, FF 14; Appeal Decision, p. 14, ¶1) does not conflict with, but instead supports, the

above-given explanation that the Thiel Table is a stored table of various settings, such as shipping features and rating components, that are used by the Thiel system to calculate shipping rates, not a table that has been generated by the Thiel system to contain calculated rates. In particular, the Board disagrees that the Thiel Table is a stored table that has not been determined by the Thiel system, "because Thiel discloses that this data is stored 'as a supplementary function in such a way that it can be called up and ascertained in a further memory region A, B, C, etc., for each country, and the appropriate zone....' (FF 14)." Appeal Decision, p. 14, ¶1. The citation in the Appeal Decision in FF 14 to Thiel at column 8, lines 50-58 is a mid-paragraph citation. The beginning of that same paragraph describes Thiel's FIG. 2, not the Thiel Table, as showing a memory region for a current postal rate table and a future postal rate table. See Thiel, col. 8, lines 39-41. Thiel also explains that "[f]or each table, the date (which is to be entered) of the date stamp that appears on the mail should be compared with the updating date, i.e., the date when the table comes into effect" Thiel, col. 9, lines 7-10. It is respectfully asserted that, based on the aforementioned disclosure of Thiel, the dates that appear in Thiel's FIG. 2 are the effective dates ("Date for Updating") for a postal rate table that can be used by the Thiel system to calculate rates for a particular "Country of Origin."

The above-mentioned paragraph in column 8 of Thiel cited by the Appeal Decision explains that "[e]very postal rate table for a national postal system is divided into zones for sending mail from the place of origin ... to the receiving locations" Thiel, col. 8, lines 46-49. It is respectfully asserted that the same paragraph then explains that "[t]he zones [as described above with respect to Thiel's FIG. 2, not the Thiel Table] ... may be stored in memory as a supplementary function in such a way that it can be called up and ascertained in a further memory region A, B, C, etc., for each country, and the appropriate zone...." Thiel, col. 8, lines 50-56.

Thiel then explains that, "[o]nce the weight and the type of mail and shipment form of the mail have been entered, the postage corresponding to the zones can be found automatically." Thiel, col. 9, lines 1-3.

Turning to the Thiel Table, it is respectfully asserted for the reasons previously given above, and for the reasons given below, that, like the postal rate table shown in

FIG. 2 of Thiel, the Thiel Table is one that has been downloaded and stored in memory for use by the Thiel system in calculating rates. For example, it is respectfully asserted that the listing in the Thiel Table of the letters "A", "B" and "C" in the row titled "Destination Zone" indicate whether or not the depicted Carrier (1-5) ships to Destination Zone A, Destination Zone B, and/or Destination Zone C. In particular, the Thiel Table depicts Carriers 1 and 4 as shipping only to Destination Zone A; Carrier 2 to Destination Zone B; Carrier 3 to both Destination Zones A and B; and Carrier 5 to Destination Zones A, B and C. See Thiel Table; Thiel, col. 11, lines 15-26. The row in the Thiel Table entitled "Return Receipt Added Charge (R)" shows that Carriers 2, 3 and 5 charge an added charge for a Return Receipt. See Thiel Table; Thiel, col. 11, lines 15-26. Thiel explains an example for shipping to Destination Zone B, stating that, "[i]n a first selection process, a mask ... searches the carriers which offer the desired services. For example, shipping to zone B and asking for a return receipt excludes carriers 1, 2 and 4² in accordance with the table above [the Thiel Table], and the further selection process is limited to carriers 3 and 5." Thiel, col. 11, lines 15-26.

Thiel further discloses that the components in the Thiel Table are used to calculate shipping fees, but are not themselves shipping fees that have been calculated by the Thiel system for shipping a particular parcel. See, e.g., Thiel Table; Thiel, col. 11, lines 27-34 (showing a price for Carrier 3 as "P3" being calculated by adding the Base Charge "B" for Carrier 3 ("B3") to the Return Receipt Added Charge "R" for Carrier 3 ("R3"), and subtracting a Discount "D" for Carrier 3 ("D3")).

For the above-given reasons, it is respectfully asserted that the Thiel Table is therefore a stored table of rating components, not a table of shipping rates that have been calculated by the Thiel system for shipping a particular parcel.

It is respectfully asserted that a table, such as the Thiel Table, that does not contain any dates or times, and further, that has not been determined according to the user's input of a request for shipping, is not a schedule of any type, and further, is not a

² It is respectfully asserted that the example explained by Thiel contains a typographical error, in that Thiel identifies Carriers 1, 2 and 4 as being eliminated by the example mask search; according to the example pre-selected services, only Carriers 1 and 4 would be eliminated according to the Thiel Table, because Carriers 1 and 4 only ship to Destination Zone A (not the selected Zone B), and neither Carriers 1 nor 4 provide a Return Receipt service, as depicted by the dash ("-") in the Thiel Table row entitled "Return Receipt Added Charge (R)" for both Carriers 1 and 4.

cross-comparison delivery schedule comprising a delivery date and a delivery time, as claimed, for example, by Claim 1. Rather, the Thiel Table is merely a tool that is used by the Thiel system to calculate rates.

Moreover, because, for the reasons previously given above which are incorporated for all purposes here, Thiel discloses a user first pre-selecting a delivery service (see, e.g., Thiel, col. 11, lines 15-23), it is therefore respectfully asserted that Thiel does not disclose generating or otherwise determining a table of elements (such as shipping rates) that are determined *for each delivery service* offered by *each of various carriers* as claimed, for example, by Claim 1.

2.B. Request for Rehearing Point 2.B Regarding the Appeal Decision Regarding Appeal Brief Argument 1a: As Compared to the Limitations of the Claims Which Provide For Determination of a Cross-Comparison Delivery Schedule That Comprises a Delivery Data and Time for Each Delivery Service Offered by Each Carrier in Response to a User Shipping Request, the Thiel Reference Discloses a User Having Already Pre-Selected a Delivery Service Before Rates are Calculated.

The Board disagreed with Appellants that "... the stored Thiel table is used to perform a mask search *after* the user has already 'defined the required services.'" Appeal Decision, p. 14, ¶12 (citing the Appeal Brief, p. 20.). Rather, the Board concluded that "there is nothing in claim 1 which requires the recited steps to be carried out in any given order as so argued." Appeal Decision, p. 14, ¶12.

It is respectfully asserted that the Board's aforementioned conclusion regarding Claim 1 appears to misapprehend not only the contents of the Thiel Table, but also, the combination of limitations claimed by Claim 1 and the Appeal Argument.

Claim 1 claims determining a cross-comparison delivery schedule comprising a delivery date and time for *each delivery service* offered by *each carrier* that would deliver a particular parcel, and claims doing so "in response to [a] respective request by [a] respective particular user ... to ship a particular respective parcel."

As compared to determining shipping information for *each* delivery service for *each* carrier, in response to a user shipping request, for the reasons previously asserted above, which are incorporated by reference in full here, it is respectfully asserted that Thiel discloses that the Thiel system relies on a user *first pre-selecting* a delivery

service, so that the Thiel system can then calculate rates for the pre-selected delivery service for various carriers that offer that delivery service. In particular, Thiel discloses that before the cited Thiel Table is used:

The user of the franking machine first defines the required services. This is done by entering the date with regard to the ship-to zone (the destination zone) and the desired additional services such as express delivery (E), return receipt (R), etc. ... In a first selection process, a mask (a first step selection) searches the carriers which offer the desired services.

Thiel, col. 11, lines 15-23.

It is respectfully asserted that the aforementioned difference between the limitations of Claim 1 and Thiel is patentable in that determining, in response to a user shipping request, a cross-comparison delivery schedule that comprises delivery dates and times for *each delivery service offered by each carrier* that would deliver a particular parcel may be useful for allowing a shipping user to compare delivery scheduling across the various delivery services offered by the various carriers.

2.C. Request for Rehearing Point 2.C Regarding the Appeal Decision Regarding Appeal Brief Argument 1a: The FedEx Reference Fails to Disclose, Either Explicitly or Inherently, Ever Determining a Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel.

The Board concluded that “the FedEx schedule displays the duration of the time in transit rather than the calculated end date, e.g. FedEx three (3) day delivery” Appeal Decision, p. 15, ¶1.

For the following reasons, and for reasons previously given above and in the Appeal Brief which are incorporated here by reference, It is respectfully asserted that the aforementioned conclusion by the Board that FedEx displays a duration of time in transit, misapprehends the FedEx reference.

It is respectfully asserted that the names of the various FedEx® delivery services, such as, for example, “FedEx 2Day®”, is not a determination of a duration of time in transit as found by the Board. Rather, as explained by the FedEx reference, the “FedEx 2Day®” delivery service provides an “[e]conomical option for delivery within 2

business days by 4:30 p.m. to most areas within the U.S.; by 7p.m. for residential deliveries ... Maximum weight: 150 lbs ... Up to 119" length, and 165" in length and girth combined ... Pickup and delivery Monday-Saturday." FF 11, p. 8.

It is respectfully asserted that the name "FedEx 2Day®" does not describe a determined time in transit, because, as disclosed by the above-mentioned description of the "FedEx 2Day®" delivery service, delivery would be made "within 2 business days." If a parcel were shipped on a Friday, the first business day would be the following Monday, unless the following Monday were a holiday; the second business day would be the following Tuesday, unless the following Monday were a holiday, in which case the second business day would be the following Wednesday. Therefore, depending on the day on which a parcel is to be shipped, the time in transit for the "FedEx 2Day®" delivery service could be two days, three days, four days or five days.

Further, whether or not a parcel could be shipped using the "FedEx 2Day®" delivery service would, according to the FedEx reference, be dependent on whether or not the parcel exceeded the maximum weight and/or exceeded one or both of the maximum dimensions identified for the service.

Further still, even if it were assumed for the sake of argument only, that the names and/or descriptions of the FedEx® services provided a time in transit, as compared to the claimed limitations for determining a delivery time for each delivery service, it is respectfully asserted that the *time* by which delivery could be expected according to the FedEx reference would be dependent on the destination to which the parcel was to be shipped, and dependent on the shipping rules of FedEx®. Yet further, it is respectfully asserted that although the shipping rules of FedEx® are described in general terms and with respect to general time frames (see FF 11, p. 8 ("... by 4:30 p.m. to most areas within the U.S.; by 7 p.m. for residential deliveries")), the shipping rules of FedEx® are not explicitly defined in the FedEx reference with sufficient specificity for a shipping user to be able to determine with certainty, the time by which a parcel would be expected to arrive at its destination. For example, a shipping user would not know with certainty, from the FedEx reference, whether or not the intended destination for the user's parcel was within an area considered by FedEx® to be one of the "most areas within the U.S." (FF 11, p. 8). Further, it is respectfully asserted that, in some cases, a

shipper may not know whether or not the destination address to which a parcel is to be shipped is a residence or not, and would therefore not know whether the parcel would be delivered by the "FedEx 2Day®" delivery service by 4:30 p.m. or by 7 p.m.

Relying on the above-mentioned misapprehension that *FedEx* displays the duration of the time in transit, the Board cited the *Leapfrog* case (*Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007)) in support of the conclusion "... that a person with ordinary skill in the art would know to automate the calculating step to determine the expected delivery date and to use the rules of delivery to result in a schedule which includes the calculated end dates." *Appeal Decision*, p. 15, ¶1. It is respectfully asserted, for the following reasons, that the aforementioned conclusion extends beyond the holding of the *Leapfrog* case and does not apply here.

In *Leapfrog*, the court found that the prior art reference, Bevan, taught all of the elements of the claimed Leapfrog patent limitations, except for the claimed processor and related electronics. *Leapfrog*, 485 F.3d at 1161. The court in *Leapfrog* further found that "[a]ccommodating a prior art mechanical device that accomplishes [the same goals] to modern electronics would have been reasonably obvious to one of ordinary skill in designing children's learning devices." *Id.* In contrast to the *Leapfrog* case, for the reasons given previously above, it is respectfully asserted that the cited combination of *FedEx* and *Thiel* fail to disclose all of the non-system elements of the claimed limitations of Claim 1.

2.D. Conclusion Regarding Request for Rehearing Point 2 Regarding the Appeal Decision Regarding Appeal Brief Argument 1a.

For the above-given reasons, and for the reasons previously given in Appellants' Appeal Brief and Reply Brief, it is therefore respectfully asserted that Claim 1 is non-obvious in view of, and is therefore patentable over, the *FedEx* and *Thiel* references. Further, it is respectfully asserted that, for reasons similar to those given above for Claim 1, the other Claims argued under Appeal Brief Argument 1a, namely, independent Claims 4 and 7, and dependent Claims 17, 22, and 23 are non-obvious in view of, and are therefore patentable over, the *FedEx* and *Thiel* references.

3. *Request for Rehearing Point 3 Regarding the Appeal Decision Regarding Appeal Brief Argument 1b: The Thiel Reference Fails to Disclose, Either Explicitly or Inherently, a Cross-Comparison Schedule That Comprises a Delivery Date and a Delivery Time in Response to a Particular User Requesting Shipment of a Particular Parcel, and Further Fails to Disclose Determining Elements For Each Delivery Service Offered by Each Carrier That Would Deliver a Parcel.*

The Board decided the Appeal with respect to Appeal Brief Argument 1b in view of Claim 2. See Appeal Decision, p. 16, ¶3. Therefore, the following assertions are presented with respect to the limitations of Claim 2.

The Board concluded that Thiel discloses "... summing and then comparing the fees of various carriers ..." and that the aforementioned disclosure meets the claimed rate calculations of Claim 2. Appeal Decision, p. 17, ¶1.

For the reasons previously given above, which are incorporated by reference here, it is respectfully asserted that Thiel discloses calculating rates for various carriers for a pre-selected service, not calculating, as claimed, rates for each delivery service offered by the various carriers. See Claim 2 (claiming calculating a shipping rate for each delivery service); see also Claim 1 (on which Claim 2 depends, claiming determining a delivery date and time for each delivery service offered by each carrier).

It is respectfully asserted that the aforementioned difference between the limitations of Claim 2 and Thiel are patentable in that calculating rates for *each delivery service offered by each carrier* that would deliver a particular parcel may be useful for allowing a shipping user to compare delivery fees across the various delivery services offered by the various carriers.

For the above-given reasons, and for the reasons previously given in Appellants' Appeal Brief and Reply Brief, it is therefore respectfully asserted that Claim 2 is non-obvious in view of, and is therefore patentable over, the FedEx and Thiel references. Further, it is respectfully asserted that, for reasons similar to those given above for Claim 2, the other Claims argued under Appeal Brief Argument 1b, namely, Claims 5, 8 and 15, are non-obvious in view of, and are therefore patentable over, the FedEx and Thiel references.

4. Request for Rehearing Point 4 Regarding the Appeal Decision Regarding Appeal Brief Argument 1c: As Compared to the Appeal Decision Statements That the Appeal Brief Argument 1c Relied on the Arguments Under Appeal Brief Argument 1b, Appeal Brief Argument 1c Advanced Additional Reasons Why Claims 3, 6, 9 and 16 Are Patentable.

The Board concluded that Appellants' argument as to the Claims in the group argued under Appeal Brief Argument 1c rested on the arguments under Appeal Brief Argument 1b.

It is respectfully asserted that the aforementioned conclusion misapprehends the argument set forth under Appeal Brief Argument 1c. Although the argument set forth under Appeal Brief Argument 1c certainly referred to the argument set forth under Appeal Brief Argument 1b, Appeal Brief Argument 1c also set forth additional reasons why Claims 3, 6, 9 and 16 are patentable. In particular, in the Appeal Brief Argument 1c, Appellants asserted that:

Thiel does not disclose, anticipate, teach or suggest "...generat[ing] a display of an online interactive prompt ... comprising a simultaneous cross-comparison of said respective shipping rates ..." because, for the reasons previously given above, *Thiel* does not disclose the above-described limitations of dependent Claims 2, 5, 8 and 15 of calculating a shipping rate for each respective particular delivery service of the plurality of delivery services offered by each respective particular carrier of the plurality of carriers that would deliver the particular respective parcel to ship a particular respective parcel according to the respective service-specific, carrier-specific delivery schedule.

Appeal Brief, p. 27, ¶2.

It is respectfully asserted, for the reasons previously given above, which are incorporated by reference here, that the *Thiel* Table does not contain rates calculated by the *Thiel* system for shipping a particular parcel. See, e.g., *Thiel*, col. 11, lines 15-23.

Further, it is respectfully asserted that *Thiel* does not display the *Thiel* Table to the user. Yet further, even if the *Thiel* Table were displayed, it does not, for the reasons previously given, contain rates calculated by the *Thiel* system for shipping a particular parcel. See, e.g., *Thiel*, col. 11, lines 15-23.

Further still, even assuming for the sake of argument only that the various rates calculated by the *Thiel* system were displayed to a user, the rates that would be

displayed would be for a *pre-selected* delivery service, not for *each* delivery service for each carrier as claimed by Claim 3, by virtue of its dependency on Claims 2 and 1. In particular, Claim 3, for example, claims displaying "... a simultaneous cross-comparison of said respective shipping rates, the display of each respective shipping rate corresponding to a display of the respective service-specific, carrier-specific delivery schedule for the respective particular delivery service to ship the particular respective parcel." Claim 3 is dependent on Claim 2, which is in turn dependent on Claim 1. Claim 1, as previously described above, claims determining a delivery schedule for each delivery service for each carrier that would ship a parcel. It is respectfully asserted that the cited references, even when considered together, fail to disclose such a simultaneous display of rates and corresponding delivery schedules in a cross-comparison. Further, it is respectfully asserted that such a simultaneous display of rates and corresponding delivery schedules would be useful over the cited references for a user to cross-compare rates and delivery dates and times, across various delivery services offered by various carriers.

For the above-given reasons, and for the reasons previously given in Appellants' Appeal Brief and Reply Brief, it is therefore respectfully asserted that Claims 3, 6, 9 and 16, are non-obvious in view of, and are therefore patentable over, the FedEx and Thiel references.

5. Request for Rehearing Point 5 Regarding the Appeal Decision Regarding Appeal Brief Arguments 1d and 1e.

For reasons similar to those given previously above regarding Claim 1, it is respectfully requested that the Board reconsider the rejection of Claims 10-13, 20 and 21 argued in Appeal Brief Argument 1d.

Further, for reasons similar to those given previously above regarding Claim 1, it is respectfully requested that the Board reconsider the rejection of Claims 19-21 argued in Appeal Brief Argument 1e.

REQUEST FOR REHEARING CONCLUSION.

Accordingly, for the above-given reasons, and for the reasons and authorities given in the Appeal Brief and in Appellant's Reply Brief, it is respectfully requested that the rejections of Claims 1-13, 15-17, and 19-23, be reversed.

Respectfully submitted,
KHORSANDI PATENT LAW GROUP, ALC

By Marilyn R. Khorsandi Jan. 29, 2010
Marilyn R. Khorsandi
Reg. No. 45,744
626/796-2856